



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/227,593 01/08/99 BESSE

M 730.010US1

021186
SCHWEGMAN LUNDBERG
WOESSNER & KLUTH, PA
PO BOX 2938
MINNEAPOLIS MN 55402

IM22/0801

EXAMINER

TOOMER, C

ART UNIT

PAPER NUMBER

1714

DATE MAILED:

08/01/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/22 7593

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 6/30/00
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-30 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-6 and 8-16 and 18-30 is/are rejected.
- ☒ Claim(s) 7 and 17 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1714

DETAILED ACTION

1. The request filed on June 30, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/227,593 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the specification for a composition which is a "non-fatty acid " or "free of fatty acid" composition.

4. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for alkoxylated alkyl and aryl phosphates, does not reasonably provide enablement for all alkyl and aryl phosphate esters. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1714

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6, 10 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, line 2, the second occurrence of "acid" should be deleted.

In claim 10, it is not clear what is being claimed with respect to 5 ethylene oxide units.

Clarification and correction are required.

In claims 10 and 20, it should be set forth that the components other than the phosphate compounds, the quaternary compound and water are additional components. These components may be identified by use of the claim language "further comprising".

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6, 8-9, 11-16, 18-19 and 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Despo (US 5,391,308) in view of Liu et al (5,244,589).

Art Unit: 1714

Despo teaches an aqueous lubricant having utility as a conveyor lubricant. The lubricant comprises C_8 - C_{12} alkyl alkoxyated phosphate, and C_8 - C_{10} alkylaryl alkoxyated phosphates, sequestering agents (EDTA) and a metallic hydroxide (encompasses sodium hydroxide) (see abstract; col. 5, line 55 bridging col. 6, lines 1-50). Despo teaches the limitations of the claims other than the differences which are discussed below.

In the first aspect, Despo differs from the claims in that he does not specifically teach that the composition of his invention contains a quaternary ammonium antimicrobe agent. However, Liu teaches this difference in a similar composition (see Liu, abstract; col. 2, lines 42-56).

It would have been obvious to one of ordinary skill in the art to have included the quaternary compound of Liu in the composition of the Despo because Despo teaches aqueous conveyor lubricants and Liu teaches that lubricants of this nature obtain improved load bearing properties and excellent antimicrobial properties upon addition of the quaternary ammonium compound.

In the second aspect, the prior art differs from the claims in that it does not specifically teach the ratio of phosphate/quaternary ammonium compound. However, no unobviousness is seen in this difference because where the general conditions of the claims are disclosed in the prior art it is not inventive to determine the optimum amount of the components through routine experimentation.

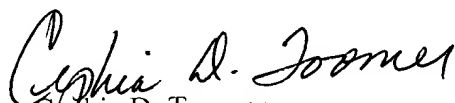
In the third aspect, the prior art fails to teach the claimed pH of the lubricant. However, it would have been obvious to one of ordinary skill in the art to have selected the claimed pH range

Art Unit: 1714

because where the general conditions of the claims are disclosed in the prior art it is not inventive to determine the optimum pH range through routine experimentation.

9. Claims 7 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to teach that the aryl phosphates comprises a phenol phosphates ester wherein said phenol group is not substituted with alkyl groups.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia Toomer whose telephone number is (703) 308-2509.


Cephia D. Toomer

Patent Examiner-1721

cdt/09227593.cpl

July 29, 2000